

REMARKS

This Request For Continued Examination is responsive to the Final Office Action mailed September 16, 2010 and the Advisory Action of December 3, 2010. Applicant has canceled Claims 3, 4, and 31 – 42, and has amended Claims 1, 5, 6, and 10 to better define the present invention. Applicant has carefully reviewed the Final Office Action and the Advisory Action, and for the reasons set forth below, respectfully request reconsideration.

Rejections Under 35 U.S.C. §102

It is black letter patent law that anticipation under 35 U.S.C. §102 requires "identity of invention:" the claimed invention, as described in appropriately construed claims, must be the same as that of the reference, in order to anticipate. Continental Can Co. USA, Inc. v. Monsanto Co., 948 F.2d 1264, 1267, 20 USPQ2d 1746, 1748 (Fed.Cir. 1991); see also In re Spada , 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed.Cir. 1990) ("the reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it"). The claims as amended cannot be shown to be shown to be anticipated by Yoon.

Each pending claim presently stands rejected under 35 U.S.C. §102(b) as being anticipated by Yoon (U.S. Patent No. 5,542,949). As amended, Claim 1 includes the feature whereby surfaces with tissue drawing openings are oriented toward each other. This can be seen, for example, in Figure 10 of the present disclosure. Conversely, while Applicant maintains its position that Yoon lacks the structure and the capability to adhere or draw in tissue, it is clear that the openings relied upon by the Office Action and the Advisory Action are on surfaces that face *away*, not toward, each other. For this reason, there can be no anticipation of Claim 1 by Yoon.

Claim 1 also recites the feature whereby the opening into which tissue is drawn is positioned between the fastener and the septum. In Yoon, the opening is outside of the

jaws and is never between the fastener and the cutting instrument the Office Action asserts is the septum. For this second reason, therefore, there can be no anticipation of Claim 1 by Yoon.

It is clear from the foregoing that Yoon does not present the required "identity of invention" that is required for a Section 102 rejection. Applicant has identified two separate limitations of Claim 1 that are not found in Yoon, or that the Office Action has not established with the required evidence of record. As such, the rejection of Claim 1 based on Yoon is properly withdrawn.

Claim 1 also stands secondarily rejected as anticipated by Adams et al., U.S. Patent No 6,585,144. Claim 1 calls for a "septum is connected while slidable in the distal to proximal direction between the first and second openings." The Office Action contends that the "septum" limitation is met by Adams' staple retainer 623. The staple retainer is removed, however, once the device is removed from its shipping package. Thus, it plays no role in the procedure and should not be considered part of the device itself. Rather, it is used to check whether an endoscope will fit through the device, and then it is discarded. [Adams, column 21 line 52 – column 22, line 11]. Clearly the device shown in FIG. 30 is not intended to, and could not be, inserted into a body cavity. Therefore, any suggestion that it is the claimed septum misinterprets what that term means to one of ordinary skill in the art. Clearly this cannot meet the limitations of the septum of Claim 1. As amended, the septum of Claim 1 is connected to the tissue positioning device while slidable in the distal to proximal direction, something the staple retainer of Adams is clearly incapable of. Thus, there can be no anticipation of Claim 1 by Adams. Claim 10, as amended, also recites that the septum is actuated from a handle, which the staple retainer clearly is not. Therefore, Claim 10 is independently patentable over Adams on this additional, independent ground.

Applicants respectfully submit that claims 1-2 and 5-12 are patentable over Yoon and Adams et al., and that all pending claims are now in condition for allowance. Reexamination and reconsideration of the application are respectfully requested and allowance at an early date is solicited.

The Commissioner is authorized to charge deposit account no. 06-2425 for any additional fees required from the filing of this paper.

Respectfully submitted,

FULWIDER PATTON LLP

By: /michael j. moffatt/
Michael J. Moffatt
Registration No. 39,304

MJM:spc
Howard Hughes Center
6060 Center Drive, Tenth Floor
Los Angeles, CA 90045
Telephone: (310) 824-5555
Facsimile: (310) 824-9696
Customer No. 24201
442713.1